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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/684,167
Filing Date: October 10, 2003
Appellant(s): WILSON, ANDREW T.

Joseph S. Makuch
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 6/7/07 appealing from the Office action mailed 12/28/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,084,168	SITRICK	7-2000
2003/0121401	ITO	7-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 11-15,27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito (USPGP 2003/012401) in view of Sitrick (USP 6084168).

Ito discloses a mixer apparatus, comprising plural apparatus 10,20,30,40 in physical proximity with each other and capable of at least one-way communication therebetween of an audio score (Fig. 1), comprising: an audio score synthesis mechanism 10,20,30 including a playing mechanism 15,27,37,53 for playing the synthesized audio score; an audio score mixing mechanism 40 coupled with said synthesis mechanism for mixing plural audio scores from 10,20,30 to produce another audio score having components of each of the plural audio scores; and an audio score input mechanism (47; S50) coupled with said mixing mechanism to provide one or more input audio scores thereto for mixing with the synthesized and outplayed played audio score (Fig. 5), said synthesis mechanism, said mixing mechanism and said input mechanism being operable in real time to create a playable audio score having components of plural audio scores produced by said plural proximate apparatus.

Ito does not explicitly disclose at least two such apparatus having an audio score mixing mechanism; i.e. configuring of the apparati 10,20,30,40 as either a "master" or as a "slave" in the system.

Sitrick discloses a music compositions communication system which comprises workstations 105 which can be configured as either a master of a network or as a slave in a network of workstations (Col. 9, lines 44-48; Col. 14, lines 48-63; Col. 16 lines 60-66; Col. 17 lines 3-12), as is known in the art to be desirable so as to allow for different musicians to be able to shift control of the overall performance based on the circumstance or particular song being played.

It would have been obvious to one of ordinary skill in the art to adapt the teachings of Ito with those of Sitrick, as both inventions are narrowly directed to musical score devices with network functionality, and as it is known in the art to be desirable to allow for different musicians to be able to shift control of the overall performance based on the circumstance or particular song being played. As such, so as to facilitate the a change between the users from a role of "master" to "slave" in such a network of Ito/Sitrick combination devices, it would have been obvious to one of ordinary skill in the art to adapt the Ito/Sitrick combination so that each device would have a mixing mechanism, as it has been held that the mere duplication of working parts does not constitute nonobviousness (see M.P.E.P. 2144.04).

(10) Response to Argument

Appellant argues that Ito only teaches that one apparatus on the network has a mixer, as differentiated from the claimed invention, which recites that each musical device having a mixing mechanism. However, it would have been obvious to one of ordinary skill in the art to adapt the Ito/Sitrick combination so that each device would have a mixing mechanism, as it has been held that the mere duplication of working parts does not constitute nonobviousness (see M.P.E.P. 2144.04).

Appellant argues that the Examiner has not identified any motivation, suggestion, or reason in Ito or any other references to include a mixing mechanism in each of the plurality of musical apparatus. The rejection, thus, is based on an impermissible hindsight reconstruction using the Applicant's disclosure as a roadmap to achieve the claimed invention. Hence, a prima facie case of obviousness has not been established.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Here, it was not only known by one of ordinary skill in the art that in a group of such devices or musical instruments that the ability to switch from a "master" to a "slave" was desirable, but Sitrick demonstrates that it was both a known problem and a

solution was taught in the prior art. This suggests to one of ordinary skill in the art that each musical apparatus have its own mixing mechanism, as Ito teaches that the "master" apparatus has a mixing mechanism. Sitrick does not explicitly teach a mixing mechanism for each musical apparatus, but again, providing e.g. four mixing mechanisms instead of just one is a mere duplication of working parts and does not constitute nonobviousness.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Jeffrey Donels

JEFFREY DONELS
PRIMARY EXAMINER

Conferees:

David Blum

Lincoln Donovan